Remarks

Claims 1-52 are currently pending, of which, claims 1, 10, 21, 29, 38 and 52 are in independent form. In the outstanding Office Action, the Examiner has rejected claims 1, 10, 21, 29, 38 and 52 under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (U.S. Patent No. 6,192,223) ("Barnett '223"). The Examiner has rejected claims 1-17, 19-25, 27-34, 36-41 and 43-52 under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2001/0006892 in the name of Barnett et al. ("Barnett '892"). The Examiner has rejected claims 18, 26, 35 and 42 under 35 U.S.C. 103(a) as being unpatentable over Barnett '892 in view of U.S. Patent No. 6,282,412 to Lyons ("Lyons"). In light of the following remarks, favorable reconsideration of the present Response as currently constituted is respectfully requested.

Rejections under 35 USC 102(e)

Rejection over Barnett '223:

Claims 1, 10, 21, 29, 38 and 52 have been rejected as anticipated by Barnett '223. Upon a review of the Barnett '223 reference, Applicant respectfully submits that Barnett '223 does not disclose each and every limitation of the rejected claims. Barnett '223 does not teach a "position locator circuit" as that term is used in the pending application. It is clear from the specification of the pending application that a "position locator

circuit" is, in essence, a circuit capable of determining its own position. Examples illustrated in the specification include global positioning system circuits and cellular network transceivers, though the scope of "position locator circuit" is not limited to these two examples. Barnett '223 fails to disclose any such circuit. Accordingly, Barnett '223 does not anticipate any of the pending claims.

Rejections over Barnett '892:

Claims 1-17, 19-25, 27-34, 36-41 and 43-52 have been rejected under 35 U.S.C. §102(e) as being anticipated by Barnett '892. Applicant has previously submitted declarations and evidence establishing conception and diligence. These declarations establish conception of the subject matter of the above-captioned application in the United States at a date prior to February 16, 2001, i.e., the effective date of Barnett '892 and reasonable diligence toward reduction of practice of the invention from at least a time just prior to the date of Barnett '892 up to the filing of the instant application on August 8, 2001.

Applicant's Showing of Conception

The Examiner has objected to Applicant's showing of conception on the ground that the evidence establishing conception fails to disclose each and every detail of the claimed invention. Mr.

Tsubaki's conception included combining a "scanner" with a global positioning system as clearly evidenced by the submitted documentary evidence. Although Mr. Tsubaki's notes of late January, 2001 do not necessarily record conception of every detail recited in the presently-pending claims, such level of detail is not required, so long as the recorded detail is sufficient to make the claimed invention apparent to one of skill in the art. *See, e.g., In re Spiller*, 500 F.2d 1170, 1176, 182 USPQ 614, 618, 619 (CCPA 1974).

It is well-established that "conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978).

In this case, the documentation submitted to the Examiner is more than sufficient to establish that Mr. Tsubaki was in possession of the invention as claimed as of January 23, 2001. As shown by the disclosure of Barnett '223, the fundamental components of a scanner (i.e., a multi-frequency receiver, a frequency database, a compiler circuit and a processing circuit) were well

known prior to conception by Mr. Tsubaki in 2001. Those of skill in the art recognize that these elements are all inherently encompassed by the term "scanner." The term "position locator circuit" is not, however, necessarily incorporated into the term "scanner," and is not inherent to a scanner. By conceiving of the combination of a scanner, with all its necessary components, and a positioning system, Mr. Tsubaki clearly conceived of the invention as claimed. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection as to the evidence establishing conception.

Showing of Reasonable Diligence under 37 C.F.R. 1.131

The total period of time elapsed from the reference date of Barnett to the filing date of the present application is approximately 6 months. Although a showing of reasonable diligence does not have a specific timetable, Applicant respectfully submits that the short period of time elapsed is, itself, evidence of reasonable diligence on the part of Applicant. It is well-established that proof of reasonable diligence does not require a party to work constantly on the invention or to drop all other work. See, e.g., *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986) (Federal Circuit found reasonable diligence where eighteen months elapsed from the time of submittal to attorney and filing of case). The question to be answered is

whether the inventor was pursuing his goal in a reasonably continuous fashion. There is no requirement whatsoever that the work be conducted in an absolutely continuous fashion. *See, e.g., Monsanto Co. v. Mycogen Plant Science, Inc.*, 61 F. Supp. 2d 133, 184 (D. Del. 1999), later appeal, 261 F.3d 1356, 59 USPQ2d 1930 (Fed. Cir. 2001):

> The Federal Circuit defines diligence as reasonably continuous activity toward reduction to practice so that the invention's conception and reduction to practice are substantially one continuous act. Diligence must be considered in light of all the circumstances and the question to answer is whether the inventor was pursuing his goal in a reasonably continuous fashion. (Emphasis added).

The Examiner will note the repeated attention to the concept of the "reasonably continuous fashion." Time and time again, the courts have emphasized that the level of effort must merely be "reasonably continuous," but have not required that such effort be "absolutely continuous." Applying the general rule of reasonable continuity to specific facts, the *Monsanto* court explained:

> The record also shows that from August 1987 until January 1988, Barton worked on construction of the AMV Bt 2, AMV Bt 3 and AMV Bt 4 plasmids. During this period, his laboratory notebook shows numerous entries reflecting his work constructing and optimizing the plasmids for use in plants.

Based on this and other evidence, the court determined that there was a "sufficient evidentiary basis" for a finding of diligence. Accordingly, reasonable gaps in continuous activity are not fatal to a showing of reasonable diligence. The question is not

necessarily whether the inventor undertook the most expeditious course to reduction to practice, so long as there was reasonably diligent activity toward the end in view. *De Solms v. Schoenwald*, 15 USPQ2d 1507, 1511 (Bd. Pat. App. & Int'f 1990). The six month period at issue here is nothing like the period in *Kollonitsch*, in which eighteen months were expended in the drafting of the applications or the four years in *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579, 38 USPQ2d 1288, 1292 (Fed. Cir. 1996). In both of these cases, reasonable diligence was found to be present even though there were gaps in continuous activity.

In the present case, Inventor Tsubaki had conceived of the invention by early February, 2001. Inventor Tsubaki's notes indicate that he had recorded his conception in documents dated January 23, 2001 and February 1, 2001. See Declaration of Arthur Tsubaki ("Tsubaki Dec."), para. 8, Exh. A, B.

After his conception of the invention in late January, Mr. Tsubaki conducted feasibility discussions with other company personnel during the month of February. See Declaration of Arthur Tsubaki ("Tsubaki Dec."), para. 8. On or about February 27, less than two weeks after the reference date of Barnett '892, Mr. Tsubaki presented the concept to management for approval. Tsubaki Dec., para. 9. Subsequent to that presentation, Mr. Tsubaki performed a preliminary engineering and product feasibility study and prepared a more detailed presentation relating to the product

direction of frequency scanning radio receivers including the GPS scanner concept. Tsubaki Dec., para. 10. On or about April 28, 2001, Mr. Tsubaki made a formal presentation to company management regarding the product direction of frequency scanning radio receivers including the GPS scanner concept. At this time, the GPS scanner concept was approved for future technology implementation and legal review. Tsubaki Dec., para. 11.

Between April 29, 2001 and May 14, 2001, Mr. Tsubaki met with Brianna Hinojosa-Flores, Intellectual Property Coordinator at Uniden regarding the GPS scanner concept and acquisition of patent protection for the GPS scanner concept. Tsubaki Dec., para. 12. By June 1, 2001, Mr. Tsubaki had drafted a formal invention disclosure, which was submitted to outside counsel on June 19, 2001. See Declaration of Lawrence R. Youst ("Youst Dec."), para. 4.

Between June 19, 2001 and July 16, 2001, Mr. Youst prepared, in his normal course of business, a draft of the patent application relating to the present invention including reviewing the invention disclosure, reviewing the prior art patents, preparing informal drawings, overseeing the preparation of formal drawings and drafting of the patent application. See Youst Dec., para. 6. During the same period, Mr. Youst completed and filed five other patent applications which had been received prior to receipt of the present application and was in the process of preparing at least

twelve other patent applications in addition to preparing at least six amendments relating to previously filed patent applications. See Youst Dec., para. 6.

On July 16, 2001, Mr. Youst forwarded a draft of the patent application relating to the present invention to Uniden for review by the inventors. Youst Dec., para. 8. Between July 16, 2001 and August 7, 2001, Mr. Youst received comments from the inventors and updated the patent application. Mr. Youst also prepared the Declaration and Power of Attorney. Youst Dec., para. 9.

On August 7, 2001, Mr. Youst obtained the inventors' written comments along with the executed Declaration and Power of Attorney of the inventors. Youst Dec., para. 10. On August 8, 2001, Mr. Youst filed the present patent application, which was granted serial number 09/924,788 and a filing date of August 8, 2001. Youst Dec., para. 11.

Upon a review of the above, it is clear that the invention proceeded from conception to constructive reduction to practice in a reasonably diligent fashion. Each step in the process was undertaken promptly and in a manner consistent with the normal course of business. Once the invention disclosure was approved and forwarded to Mr. Youst, he took up the disclosure, prepared a draft, and forwarded the draft to the inventor in a prompt and efficient manner. Accordingly, Applicant respectfully submits that the facts compel a finding that the application was filed in a

reasonably diligent manner, consistent with the requirements of 37 C.F.R. 1.131.

Accordingly, Applicant respectfully submits that the §102(e) rejections are rendered moot. Further, Applicant respectfully requests withdrawal of the outstanding §102(e) rejections and allowance of claims 1-17, 19-25, 27-34, 36-41 and 43-52.

Rejections Under 35 U.S.C. §103(a)

Claims 18, 26, 35 and 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Barnett '892 in view of Lyons. In each of the §103(a) rejections, the Examiner relies on Barnett, which is prior art under 35 U.S.C. §102(e). As stated above, Applicant conceived prior to the filing of the Barnett reference and acted with reasonable diligence toward the completion of the invention from the time of conception, to a time just prior to the date of Barnett '892, up to the filing of the instant application on August 8, 2001. Accordingly, Applicant respectfully submits that the §103(a) rejections are rendered moot. Further, Applicant respectfully requests withdrawal of the outstanding §103(a) rejections and allowance of claims 18, 26, 35 and 42.

Fee Statement

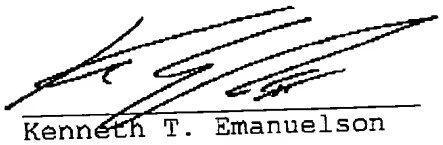
Applicant has enclosed herewith a Form PTO-2038 authorizing payment in the amount of $1020.00 for a three-month extension of time. Compared to the initial filing, in the present Response, the number of independent claims has remained the same and the total number of claims has remained the same. Applicant believes no additional fees are due for the filing of this Response. If any additional fees are due or overpayment have been made, please charge or credit, our Deposit Account No. 03-1130.

Conclusion

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the outstanding objections and rejections and allow claims 1-52 presented for reconsideration herein. Accordingly, a favorable action in the form of an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 16th day of June, 2006.

Respectfully submitted:



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